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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/325,040	06/07/1999	JON A. BREWSTER	10991693-1	2318

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EXAMINER
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MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/325,040	Applicant(s) Brewster et al
	Examiner James W. Myhre

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on May 6, 2003.

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-22 and 33-48 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-22 and 33-48 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on May 6, 2003 under 37 CFR 1.111 is sufficient to overcome the Griebenow et al (5,850,520) and Logan et al (5,721,827) references. The amendment verified the withdrawal of Claims 23-32 and 49-76 as per the election/restriction agreement of January 6, 2003. The claims under current consideration are Claims 1-22 and 33-48.

### ***Claim Rejections - 35 USC § 101***

2. The amendment filed on May 6, 2003 amended Claims 34-48 to include a document server which overcomes the non-statutory subject matter rejection in paragraph 7 of paper number 9. Therefore, the Examiner hereby withdraws that rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-3, 12-15, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griebenow et al (5,850,520) in view of Austin (6,157,924).

Claim 1: Griebenow discloses a method for automatically printing a document, comprising:

- a. Storing a print schedule (col 4, lines 25-31 and col 8, lines 19-33);
- b. Automatically requesting and receiving the document without user intervention (col 4, lines 32-45 and col 8, lines 19-33).

Griebenow discloses the document being automatically sent to the user, but does not explicitly disclose that the document will also be automatically printed on the user's printing device. Austin discloses a similar method for delivering information to a user in which the method of delivery (e.g. print) is chosen by the user and stored in the user profile. When the desired information is retrieved and sent to the user, it is formatted into the desired format; explicitly "If a determination is made that the delivery medium is to be printed copy (Block 160), the retrieved information, and any additional information, is formatted as a printed copy (Block 162). The printed copy is then delivered to a user's printer (Block 164)" (col 13, lines 35-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to automatically send the document in Griebenow to the user's printer if the user had indicated his desire to receive a printed copy. One would have been motivated to send the document directly to the printer in order to deliver the document in the preferred medium and to eliminate the need

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for the user to perform the tedious steps of downloading each file, opening each file, and selecting the print button to manually print each file.

Claim 2: Griebennow and Austin disclose a method for automatically printing a document as in Claim 1 above, and Griebennow further discloses storing a user profile (col 6, lines 65-67).

Claim 3: Griebennow and Austin disclose a method for automatically printing a document as in Claim 2 above, and Griebennow further discloses updating the user profile to reflect the delivery (printing) of the document (col 7, lines 10-55).

Claim 12: Griebennow and Austin disclose a method for automatically printing a document as in Claim 2 above, and Griebennow further discloses including advertising content in the document (col 5, lines 12-22).

Claims 13, 14, and 33: Griebennow and Austin disclose a method for automatically printing a document as in Claims 3 and 12 above, and Griebennow further discloses personalizing the advertising content and the document content based on the user profile (col 5, lines 12-22 and col 6, lines 65-67).

Claim 15: Griebennow and Austin disclose a method for automatically printing a document as in Claim 13 above, and Griebennow further discloses updating the user profile to reflect the printing of the document (col 7, lines 10-55).

5. Claims 34-38 and 43-48 are rejected under 35 U.S.C. 103(a) as being anticipated by Logan et al (5,721,827).

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Claim 34: Logan discloses a method for subsidizing printing of documents, comprising:

- a. Monitoring the usage of a printing device (col 26, lines 53-59); and
- b. Subsidizing the purchase of a product based on the monitoring step (col 26, lines 53-59),

lines 53-59).

While Logan discloses monitoring the usage of an audio device instead of a printing device, both devices are being used to deliver a desired electronic content file to a user. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the method steps in Logan could be used to monitor any electronic information delivery device to include a printer, an audio device, a video device, a computer, or even a copier machine. One would have been motivated to monitor the usage of other types of devices, such as a printer, in view of Logan's disclosure that the downloaded files could contain audio, text, or both.

Claims 35-38: Logan discloses a method for subsidizing printing of documents as in Claim 34 above, and further discloses updating a user profile with an indication that an advertisement has been printed in the document and with the amount of resources (e.g. ink, paper, etc.) That has been used to print the document (col 26, lines 53-59).

Claims 43-45: Logan discloses a method for subsidizing printing of documents as in Claim 34 above, and further discloses various funding sources, such as advertising and distribution revenues (col 6, lines 1-9 and col 20, lines 3-7).

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Claims 46-48: Logan discloses a method for subsidizing printing of documents as in Claim 35 above, and further discloses providing the monitored information to a third part, such as an advertiser or content provider (col 27, lines 4-27).

6. Claims 4-11, 16-22, and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griebenow et al (5,850,520) in view of Austin (6,157,924) and in further view of Logan et al (5,721,827).

Claims 4 and 16: Griebenow and Austin disclose a method for automatically printing a document as in Claims 3 and 15 above, but do not explicitly disclose subsidizing a product for a user based on updating the user profile. However, Logan discloses a similar method for printing document which include advertisements like Griebenow and which also discloses subsidizing the user based on updating the user profile (col 26, lines 53-59). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the advertising revenue discussed in Griebenow (col 6, lines 2-12) to subsidize the cost to the user for printing the document. One would have been motivated to subsidize the user's cost in this way in order to entice the customers to use the system.

Claims 5-11, 17-22, and 39-42: Griebenow, Austin, and Logan disclose a method for automatically printing and subsidizing a document as in Claims 4, 16, and 34 above. All three references further disclose sending various types of advertising and promotional products, such as a free or discounted print consumable, printable media (e.g. coupon), or product to the user

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(Griebelnow, col 10, line 58 - col 11, line 22)(Austin, col 10, lines 34-44 and 59-67)(Logan, col 24, lines 1-14). While none of the references explicitly discloses that the advertising content includes a coupon, coupons are old and well known form of advertisements and would have been an obvious choice for the advertisers in Griebelnow or in Logan. One would have been motivated to present a coupon to the user in order to entice the user to buy the product by clicking on the “purchase” or “order” link discussed in each reference.

***Response to Arguments***

7. Applicant's arguments filed May 6, 2003 have been fully considered but they are not persuasive.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

  
JWM  
July 2, 2003

  
James W. Myhre  
Primary Examiner  
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